

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04 February 2010 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6, 10-12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0136774 to O'Boyle ("O'Boyle") in view of U.S. Patent Application Publication No. 2003/0030269 to Hernandez ("Hernandez") and further in view of U.S. Patent No. 4,932,520 to Ciarcia et al. ("Ciarcia").

Regarding claim 1, O'Boyle discloses a filing notebook (notebook 10) comprising:

- i) a cover including a front leaf (front cover 17) and a back leaf (back cover 18); ii) a binder (spiral binding 11) joining the front and back leaves together (see fig. 2); and iii) inner notebook pages (sheets 16) connected to the binder between the front and back

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leaves (see fig. 2), but fail to disclose: i) the notebook pages being detachable; and ii) inner separation sheets with tabs inseparably connected to the binder for filing notebook pages separated from the binder between adjacent inner separation sheets of the notebook.

Hernandez teaches the concept of providing detachable pages disposed within a notebook (via perforations 26a and 26b, per paragraph 54).

Ciarcia teaches the concept of providing inner separation sheets (envelopes 40) with tabs (enclosures 52) inseparably connected to a binder for filing notebook pages separated from the binder between adjacent inner separation sheets of a notebook (see fig. 1).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include Hernandez perforations within the O'Boyle sheets in order to render the sheets separable from the notebook after they have been sufficiently used, as explicitly taught by Hernandez (see paragraph 54).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to disperse Ciarcia envelopes throughout the O'Boyle sheets, attaching them to the spiral binding in order to retain pages removed from other areas of the notebook assembly, as explicitly taught by Ciarcia (see col. 3, lines 64-67).

Regarding claim 2, O'Boyle in view of Hernandez and further in view of Ciarcia discloses the filing notebook of Claim 1, wherein each notebook page includes a scored line that is parallel to the binder, in proximity to the binder, and along which the notebook page can be detached in order to file the notebook page in a compartment

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between two adjacent inner separation sheets (see the combination set forth in the rejection of claim 1, above).

Regarding claim 3, O'Boyle in view of Hernandez and further in view of Ciarcia discloses the filing notebook according to Claim 1, wherein the inner separation sheets are located between the notebook pages of the notebook and the back leaf (see the combination set forth in the rejection of claim 1, above).

Regarding claim 4, O'Boyle in view of Hernandez and further in view of Ciarcia discloses the filing notebook according to Claim 1, wherein the tabs are located at different heights on the inner separation sheets (see Ciarcia fig. 1).

Regarding claim 6, O'Boyle in view of Hernandez and further in view of Ciarcia discloses the filing notebook according to Claim 1, wherein the front leaf makes the tabs of the inner separation sheets visible and directly accessible when the notebook is closed (see the combination set forth in the rejection of claim 1, above, in light of O'Boyle fig. 1 and Ciarcia fig. 1).

Regarding claim 10, O'Boyle in view of Hernandez and further in view of Ciarcia discloses the filing notebook according to Claim 1, wherein the binder includes a spiral (see O'Boyle paragraph 20).

Regarding claim 11, O'Boyle in view of Hernandez and further in view of Ciarcia discloses the filing notebook according to Claim 1, wherein the notebook pages are perforated for filing in another notebook (see O'Boyle fig. 2, showing holes 12).

Regarding claim 12, O'Boyle in view of Hernandez and further in view of Ciarcia discloses the filing notebook according to Claim 1, wherein compartments between the

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inner separation sheets can receive pages other than the notebook pages (see Ciarcia fig. 3; note that the pocket arrangement allows a multitude of different articles to be retained therein).

Regarding claim 16, O'Boyle in view of Hernandez and further in view of Ciarcia discloses the filing notebook according to Claim 4, wherein the front leaf makes the tabs of the inner separation sheets visible and directly accessible when the notebook is closed (see the combination set forth in the rejection of claim 1, above, in light of O'Boyle fig. 1 and Ciarcia fig. 1).

4. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Boyle in view of Hernandez and further in view of Ciarcia and U.S. Patent No. 5,651,628 to Bankes et al. ("Bankes").

Regarding claim 5, O'Boyle in view of Hernandez and further in view of Ciarcia discloses the filing notebook according to claim 1, but fails to disclose the front leaf invisibly covering the tabs of the inner separation sheets when the notebook is closed.

Bankes teaches the concept of providing a front leaf invisibly covering the tabs of inner separation sheets when a notebook is closed (see fig. 2d).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to apply the Bankes extended cover teachings to the notebook of O'Boyle in view of Hernandez and further in view of Ciarcia in order to protect the tabs from damage, as explicitly taught by Bankes (see col. 3, lines 7-12).

Regarding claim 15, O'Boyle in view of Hernandez and further in view of Ciarcia, as modified by Bankes (in the manner set forth in the rejection of claim 5, above),

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discloses the filing notebook according to Claim 4, wherein the front leaf invisibly covers the tabs of the inner separation sheets when the notebook is closed (see the combination set forth in the rejection of claim 5, above).

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Boyle in view of Hernandez and further in view of Ciarcia and U.S. Patent Application Publication No. 2002/0089166 to Schwartz ("Schwartz").

Regarding claim 7, O'Boyle in view of Hernandez and further in view of Ciarcia discloses the filing notebook according to claim 1, but fails to disclose one of the front and back leaves including flaps along upper, lower, and side edges.

Schwartz teaches the concept of providing leaves with flaps (corners 3) along upper, lower and side edges of a substrate sheet (see fig. 1).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to attach Schwartz corners to the front and/or back covers of the notebook of O'Boyle in view of Hernandez and further in view of Ciarcia in order to securely hold a leaf of paper, as explicitly taught by Schwartz (see paragraph 48).

6. Claims 8-9 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Boyle in view of Hernandez and further in view of Ciarcia and U.S. Patent Application Publication No. 2004/0253046 to Africa et al. ("Africa").

Regarding claim 8, O'Boyle in view of Hernandez and further in view of Ciarcia discloses the filing notebook according to claim 1, but fails to disclose at least one closing means for keeping the notebook closed and including an elastic band fastened

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to one of the front and back leaves by rivets, sliding relative to the leaf via eyelets, and for pulling over a corner of the back or front leaf parallel to the binder.

Africa teaches the concept of providing at least one closing means for keeping a notebook closed and including an elastic band (loop of elastic material 68) fastened to one of the front and back leaves by rivets (see paragraph 17), sliding relative to the leaves via eyelets, which may be for pulled over a corner of the back or front leaf parallel to the binder (see fig. 1).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to attach the Africa loop of elastic material to the notebook of O'Boyle in view of Hernandez and further in view of Ciarcia in order to maintain the notebook in its closed position, as explicitly taught by Africa (see paragraph 17).

Regarding claim 9, O'Boyle in view of Hernandez and further in view of Ciarcia and Africa discloses the filing notebook of Claim 8, wherein the closing means can be pulled over a corner of the inner separation sheets (see Africa fig. 1).

Regarding claim 13, O'Boyle in view of Hernandez, and further in view of Ciarcia, as modified by Africa (in the manner set forth in the rejection of claim 8, above), discloses the filing notebook according to Claim 1, including at least one closing means for keeping the notebook closed (Africa loop of elastic material 68) and including an elastic band fastened to one of the front and back leaves by rivets, sliding relative to the leaf via eyelets, and for pulling over the front or back leaf and parallel to the binder (see the combination set forth in the rejection of claim 8, above).

Regarding claim 14, O'Boyle in view of Hernandez, and further in view of Ciarcia and Africa discloses the filing notebook of Claim 8, wherein the closing means can be pulled entirely over the inner separation sheets (see the combination set forth in the rejection of claim 8, above).

7. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Boyle in view of Hernandez and further in view of Ciarcia and U.S. Patent No. 2,551,784 to Bauer ("Bauer").

Regarding claim 17, O'Boyle in view of Hernandez and further in view of Ciarcia discloses a filing notebook (O'Boyle notebook 10) comprising: i) a cover including a front leaf (O'Boyle front cover 17) and a back leaf (O'Boyle back cover 18); ii) a binder (O'Boyle spiral binding 11) joining the front and back leaves together (see O'Boyle fig. 2); iii) inner notebook pages (O'Boyle sheets 16) connected to the binder between the front and back leaves (see O'Boyle fig. 2), wherein the notebook pages are detachable (see the combination set forth in the rejection of claim 1, above); iv) inner separation sheets (Ciarcia envelopes 40) with tabs (Ciarcia enclosures 52) inseparably connected to the binder (see the combination set forth in the rejection of claim 1, above) for filing notebook pages separated from the binder between adjacent inner separation sheets of the notebook (see the combination set forth in the rejection of claim 1, above), wherein the inner separation sheets are located between the notebook pages of the notebook and one of the front and back leaves (see the combination set forth in the rejection of claim 1, above), but fails to disclose at least one closing means including an elastic band fastened to one of the front and back leaves by rivets sliding relative to the leaf via

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eyelets, wherein the elastic band is adapted to be pulled over corners of the superimposed inner separation sheets so that the separation sheets are adapted to secure notebook pages between the separation sheets and notebook pages attached to the binder are available for use.

Bauer teaches the concept of providing at least one closing means including an elastic band (elastic cord 27) fastened to one of a body of front and back leaves by rivets (buttons 26) sliding relative to the leaf via eyelets (see fig. 1), wherein the elastic band is adapted to be pulled over corners of the superimposed inner separation sheets so that the separation sheets are adapted to secure notebook pages between the separation sheets and notebook pages attached to the binder are available for use (see fig. 1; note that such function could be accomplished given the shown arrangement, in addition to other functions).

Regarding claim 18, O'Boyle in view of Hernandez, and further in view of Ciarcia, as modified by Bauer (in the manner set forth in the rejection of claim 17, above), discloses a filing notebook (O'Boyle notebook 10) comprising: i) a cover including a front leaf (O'Boyle front cover 17) and a back leaf (O'Boyle back cover 18); ii) a binder (O'Boyle spiral binding 11) joining the front and back leaves together (see O'Boyle fig. 2); iii) inner notebook pages (O'Boyle sheets 16) connected to the binder between the front and back leaves (see O'Boyle fig. 2), wherein the notebook pages are detachable (see the combination set forth in the rejection of claim 1, above); iv) inner separation sheets (Ciarcia envelopes 40) with tabs (Ciarcia enclosures 52) inseparably connected to the binder (see the combination set forth in the rejection of claim 1, above) for filing



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notebook pages separated from the binder between adjacent inner separation sheets of the notebook (see the combination set forth in the rejection of claim 1, above), wherein the inner separation sheets are located between the notebook pages of the notebook and one of the front and back leaves (see the combination set forth in the rejection of claim 1, above); and v) at least one closing means including an elastic band (Bauer elastic cord 27) fastened to one of the front and back leaves by rivets sliding relative to the leaf via eyelets, wherein one of the front and back leaves includes flaps along upper, lower, and side edges which, when in a folded-down position with respect to the front or back leaf, form a pocket for storing inner separation sheets capable of containing therebetween notebook pages separated from the binder, and wherein the elastic band is adapted to be pulled over corners of the folded-down flaps storing inner separation sheets (see the combination set forth in the rejection of claim 17, above).

### ***Response to Arguments***

In response to Applicant's argument that the previously issued Office Action fails to explain why it would have been obvious to one of ordinary skill in the art to modify O'Boyle to have separation sheets that are inseparable from a binder that joins front and back leaves together (see Applicant's Arguments/Remarks pg. 6, line 20-22), Examiner respectfully asserts that as set forth in the instant and previous Office Actions, it would have been obvious to a person of ordinary skill in the art to add the particular separation pages of Ciarcia to the O'Boyle binder in order to provide a means by which to store other pages which are not physically attached to the O'Boyle binder.

In response to Applicant's argument that a person of ordinary skill in the art looking for a way to store detached sheets within a notebook would not look to Hernandez (see Applicant's Arguments/Remarks pg. 7, lines 3-4), Examiner agrees. Accordingly, the Hernandez reference is not currently and was not previously used for such purpose. Rather, Hernandez is and was used for its teachings of detachable pages.

In response to Applicant's argument that Ciarcia fails to disclose separation sheets with tabs inseparably connected to a binder that joins the front and back leaves together (see Applicant's Arguments/Remarks pg. 7, lines 12-14), Examiner respectfully asserts that Applicant has incorrectly construed the concept which Examiner views as the teaching of "inseparability." Ciarcia col. 3, lines 32-35 clearly provides that said separation sheets are inseparably bound within an assembly most clearly shown in fig. 3. In proposing the combination of O'Boyle with Ciarcia, Examiner's intent is and was to take the inseparably bound separation sheet of Ciara fig. 3 and inseparably bind said sheet within the O'Boyle assembly.

In response to Applicant's argument that the combination of Bauer with O'Boyle, as modified by Hernandez and Ciarcia would result in a structure very different from the claimed notebook (see Applicant's Arguments/Remarks pg. 9, lines 8-15), Examiner respectfully asserts that Applicant has incorrectly construed the combination that Examiner made. Within the instant and prior Office Actions, it is clearly stated that the only the Bauer rivets and elastic cords are used to modify the assembly, rather than the entire Bauer book protector as Applicant attempts to state.

In response to Applicant's argument that Bauer does not disclose or suggest pulling the elastic band over corners of inner separation sheets that are inseparably connected to the binding to secure notebook pages separated from the binder between the inner separation sheets, as claimed in claim 17 (see Applicant's Arguments/Remarks pg. 9, lines 18-21), Examiner respectfully reminds Applicant that as drafted, claim 17 merely requires a structure "adapted to be pulled over corners..." as opposed to a method detailing the manner in which the structure is used.

In response to Applicant's argument that the use of Schwartz teachings will result in an apparatus different from that which Applicant has claimed (see Applicant's Arguments/Remarks pg. 10, lines 8-12), Examiner respectfully asserts that Applicant has failed to accurately state the combination proposed by Examiner within the instant and previous Office Actions, and in said Arguments/Remarks consequently proposes a resultant apparatus differing substantially from that which Examiner actually provides.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN V. LEWIS whose telephone number is (571)270-5052. The examiner can normally be reached on M-F 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on (571) 272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dana Ross/

Supervisory Patent Examiner, Art Unit 3725

/JVL/